

REMARKS

Claims 1-10 and 13-26 are pending in the application. Claims 20, 23 and 24 have been allowed.

Claims 1-4, 6-8, 13, 14, 16, 18 and 25 have been newly rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Greer, U.S. Patent 3,627,612.

Claims 5, 17 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greer '612.

It is respectfully submitted that the Greer reference cannot anticipate nor render obvious Applicants' claimed subject matter. As thoroughly detailed hereinbelow, the Greer reference lacks numerous features specifically claimed in the pending claims.

1) First, Greer cannot anticipate and actually has a scope and content that teaches away from Applicants' independent claim 1 claimed "strip-shaped lateral wall having a length measured parallel to the peripheral wall and having a linear vertical cross-section along the length of the lateral wall." To summarize, Applicants claim a straight lateral wall in vertical cross section. However, the Examiner states that he considers the lateral wall of Greer "to be solely portion 26 excluding portions 27 and 28". It is respectfully submitted that the Examiner cannot simply ignore sections 27 and 28 of the Greer lid wall! Sections 27 and 28 are indeed part of the lid and are part of the lateral wall as defined within Applicants' specification. Accordingly, the Examiner has not considered the entire length of the lateral wall as specifically claimed in claim 1 and only considers portion 26 of the wall including reference numbers 26, 27 and 28. The Examiner has not presented a prima facie case of anticipation nor obviousness. There is no break between the continuous sections of the lateral wall of Schlensker including sections 26, 27 and 28. A prima facie case requires some reason, suggestion, or motivation from the prior art as a whole for the person ordinary skill in the art to have combined or modified the references. It is incorrect for the Examiner to formulate the suggestion or motivation based upon current knowledge. The Examiner must remove all knowledge that he or she has accumulated since the date of invention. As stated by the Federal Circuit:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Cutting against the finding of motivation to modify the prior art is when the scope and content of the prior art teaches away from the claimed limitation. One of ordinary skill in the art upon reading the Greer reference would be led in a direction divergent from the path that the Applicant took. Greer teaches a lid having a lateral wall which is clearly not linear along its length and there is no motivation to modify the reference otherwise. In fact, as explained further hereinbelow, the structure of the Greer lateral wall is to retain a portion of a bladder between the lateral wall and the container outer wall.

Moreover, section 2141.02 of the MPEP states that ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole (emphasis added). Furthermore, the last portion of the noted section includes the heading "prior art must be considered in its entirety, including disclosures that teach away from the claims". The Federal Circuit has further stated: A prior art reference must be considered in its entirety, i.e. as a whole, including portions would lead away from the claimed invention. W.L. Gore & Associates, Inc. v Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In In re Wesslau, the Court of Customs and Patent Appeals cautioned that "it is impermissible within ...to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." 353 F.2d at 241, 147 USPQ at 393. In Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 USPQ 2d 1929 (N.D. Calif. 1989), the Federal Circuit

held that a single line in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness.

Accordingly, it is respectfully submitted that the Examiner cannot merely consider wall 26 as being the claimed "entire length of the lateral wall" when clearly portions 27 and 28 are a part of and also form the lateral wall of the Greer lid along with portion 26. To do so would ignore the teachings of the Greer reference and introduce impermissible hindsight reasoning.

II) Independent claim 1 also claims that the lateral wall is fitted at the inner side of the peripheral wall of the cartridge container. Greer cannot anticipate, nor teach or suggest the same. As clearly shown in Fig. 1, Greer bladder 31 includes a thickened rim, 32 which is interposed between sleeve 26 of the outer lateral wall of the lid and the peripheral wall of the container. Accordingly, Greer cannot anticipate Applicants' claimed limitation, includes the scope and content that teaches securing a portion of bladder 31 between a container wall and the lid lateral wall and teaches that the lateral wall is thus not fitted at the inner side of the peripheral wall.

III) Furthermore regarding claim 1, Greer cannot anticipate nor render obvious the limitation wherein the lid bottom merges with the lateral wall in the direction of the peripheral wall along an inward curved edge section. The Greer lid bottom 22 curves toward the peripheral wall then extends downward toward the center of the container and then merges outward with the lateral wall at a U-shaped edge. There is no merging of the lid bottom with the lateral wall along the claimed inward curved edge section.

IV) Moreover, there is no Greer common wall section that tapers inward in the forming region.

V) Also, independent claim 1 claims that the lower end of the common wall is parallel to the cartridge container peripheral wall adjacent thereto. As argued above, Greer has no common wall. As illustrated in Fig. 1, the lower end of the Greer periphery area 25 is not adjacent the peripheral wall, but instead adjacent rim 32 of bladder 31.

VI) Moreover, independent claim 1 claims that the lateral wall has an upper wall section which is connected to and extends upward from the common wall section that is parallel to the common wall section lower end in the cartridge container peripheral wall adjacent thereto. As described hereinabove, the Greer reference, when considered as

a whole as required by law, teaches a lateral wall which includes portions 26, 27 and 28 extending upward from the section 25. Sections 26, 27 and 28 are clearly not parallel to the common wall section lower end and the cartridge container peripheral wall adjacent thereto. Moreover, as explained hereinabove, rim 32 of bladder 31 is interposed between at least one section, i.e. section 26 of the Greer lateral wall.

Likewise, claim 25 includes limitations present within independent claim 1 and likewise cannot be anticipated nor taught or suggested.

Claim 2 claims that in vertical cross-section the lateral wall is a linear tangent line, and wherein the lateral wall is connected with the curved edge section tangentially. Applicant has previously explained the definition of a tangent to the Examiner. Greer lateral wall 26, 27 and 28, i.e. the lid wall portions lateral to the container peripheral wall, is not a linear tangent line as claimed. The Greer lid bottom 22 does not connect with the lateral wall tangentially, but instead transitions into the lateral wall portion 26 at a rounded periphery 25. Fig. 1 shows a clear line of separation between lid bottom 23 and lateral wall section 26 which remains unbroken until reaching periphery 25. Considering the scope and content of the Greer reference, it is unclear what a person of ordinary skill in the art would have known or could have done when provided with the Greer reference as neither of the Greer lateral wall 26, 27 and 28 are a linear tangent line nor does the lateral wall connect with a curved edge section tangentially.

Regarding claim 5, the Examiner states Greer does not teach the claimed dimensional relationship but the recitation is deemed a dimensional change. The Examiner further cites Gardner v. Tec Systems, Inc. which states:

"Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device" (emphasis added).

However, as described hereinabove, there are numerous differences between the Greer reference and the claims other than the relative dimensions. When considered overall, the Greer reference structure is much different than the claimed

structure as indicated hereinabove. Accordingly the Examiner's reliance on Gardner is improper.

Moreover, the Examiner states that absent some showing of secondary evidence that the claimed range for the curvature substantially differentiates from the prior art, the claimed recitation is deemed a dimensional change. Greer, like the Schlensker reference, does not present any relative dimensions regarding the radius of curvature of his lid. As reiterated by the Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ____ (2007), the basic inquiries regarding the question of obviousness set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966). The factual inquiries enunciated by the court are as follow: 1) determining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. By the Examiner's characterization of Greer, it is clear that there is no recognition of the importance of the radius of curvature in comparison to the curved peripheral wall thickness within the scope and content of the Greer reference. It is unclear from the teachings of the Greer reference how a person of ordinary skill would have understood the prior art Greer teachings or what a person of ordinary skill would have known or could have done in view of the teachings of the Greer reference to arrive at Applicants' claimed limitation regarding the radius of curvature.

Regarding some showing of secondary evidence, Applicant has previously pointed to page 5 of the present application, where it is stated that it was also found that the greater the radius of curvature of the curved edge section, the more favorable is the force distribution, whereby the upper limit is given by the dimensions of the cartridge container. Thus, having a greater radius of curvature, which cannot be solved by Greer, allows the forces acting on the lid due to the internal pressure to be weakened in the edge area, and can be used for generating a sealing force whereby due to the radius of curvature, the common wall section is pressed against the peripheral wall of the cartridge container, see page 4, third full paragraph. Clearly secondary evidence regarding the importance of the claimed feature has been provided. It is respectfully submitted that the gap between prior art and the claimed invention is so great as to render the claim non-obvious to one reasonably skilled in the art.

Claims 9, 10, 19 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greer '612 in view of Stifano, U.S. Patent 4,109,820.

Regarding claims 9, 10, 19 and 21, there is no motivation to utilize a back-up ring in conjunction with Greer. Greer teaches that the container outer peripheral wall has a free edge 41 of the container that is reversely bent as at 42 over the upper edge 43 of sleeve 28 securely to retain the cover member 21 in fixed position, see column 3, lines 8-10. Accordingly, the scope and content of the Greer reference teaches away from any back-up ring which would be completely unnecessary!

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Greer '612 in view of Gizowski et al, U.S. publication 2001/0000894.

As indicated hereinabove, the Greer container wall is reversely bent over the upper edge of sleeve 28 of the lid in order to retain the lid in a fixed position. Therefore, a cartridge container transparent to laser light is unnecessary as there would be no further need to bond the lid to the container.

Claims 1-8, 13, 14, 16, 18, 25 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schlensker et al., WO 02/38247, U.S. Patent No. 6,936,084 for English Translation.

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schlensker '247 in view of Gizowski et al, U.S. Publication 2001/0000894.

Claims 9, 10, 19 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schlensker '247 in view of Stifano, U.S. Patent 4, 109,820.

It is respectfully submitted that the Schlensker reference cannot anticipate, nor render obvious independent claim 1. Claim 1 states that the lid includes a strip-shaped lateral wall having a linear vertical cross section along the entire length of the lateral wall. The limitation clearly indicates that the entire length of the lateral wall has a linear vertical cross section as illustrated, for example, in FIG. 2a which includes lateral wall 16. Schlensker's Fig. 1, see Exhibit A, includes a lateral wall 24, adjacent container peripheral wall 20, clearly does not have a linear vertical cross section along the entire length of the lateral wall. Schlensker teaches a stepped upper wall section shown in the bottom portion of Fig. 1 as well as an angled portion present in the common wall section located upwardly of the upper wall section shown in Fig. 1.

Claim 1 further states that the lateral wall upper wall section, see 17 in Fig. 2a, is connected to and extends upward from the common wall section 18 that is parallel to the common wall section lower end and the cartridge container peripheral wall adjacent thereto. The Schlensker upper wall section connected to and extending upwardly from the common wall section clearly includes on its interior surface a stepped section which provides the upper wall section with a stepped appearance. Accordingly, the Schlensker upper wall section cannot be parallel to the common wall section lower end and is further not parallel to the cartridge container peripheral wall adjacent thereto.

It is respectfully submitted that the scope and content of the Schlensker reference cannot anticipate, nor render obvious at least Applicants' noted claim limitations set forth in independent claim 1.

Regarding claim 2, the Examiner states that the Schlensker lid curves completely 90° until it is parallel to the peripheral wall. At this point the curved section is joined to the lateral wall and is a tangent line to the curve. The Examiner further states comparing the Applicants' figures and the figure of Schlensker same structures are present (emphasis added).

However, as indicated by the 103 rejection of claim 1, the Examiner notes differences between the Schlensker reference and Applicants' claimed invention. Therefore, the same structure cannot be present! Schlensker specifically lacks the entire length of the lateral wall having a linear vertical cross section. Therefore, with respect to claim 2, Schlensker cannot include a linear tangent line. Considering the Schlensker reference as a whole, the scope and content thereof leads one of ordinary skill in the art away from the claimed invention and provides no motivation whatsoever for a tangential connection as claimed.

Regarding claim 5, the Examiner again cites the Gardner reference noted hereinabove which states:

"Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device" (emphasis added).

The Examiner's reliance on Gardner is misplaced as the limitations of claim 5 are clearly not the only difference between the prior art and the claims as evidenced by the Examiner's §103 and not §102 rejection of parent claim 1. Specifically, claim 5 refers to independent claim 1 upon which the Examiner states "Schlensker does not teach the lateral wall having a linear cross-section along its length". Accordingly, the Gardner reference is not applicable.

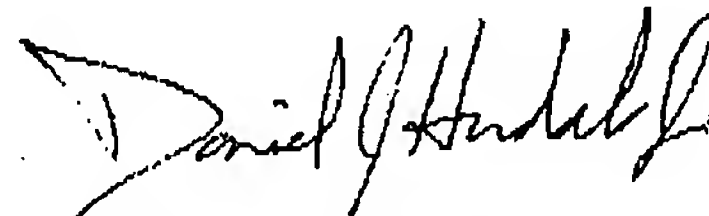
Moreover, as indicated in the prior response and further described above, secondary evidence has been provided which clearly differentiates Schlensker from the claimed invention and is clearly not a "simple change in dimension". Having the ability to reduce the load in the critical area of the peripheral wall at the lower end of the fastening area so that leakages are effectively prevented thereby extending service life of the filter cartridge is not a trivial change!

Regarding claim 9, it is claimed that the back-up ring has a plurality of radially reinforcing ribs connected to and extending between the back-up ring inner wall and back-up outer lateral wall. None of the references anticipate, nor teach or suggest the same. The claimed arrangement allows for a better distribution of forces that are not within the scope and content of the cited references.

It is respectfully submitted that the claims are in condition for allowance and a Notice of such is earnestly solicited. Should the Examiner have any questions or concerns regarding this response, a telephone call to the undersigned is greatly appreciated in order to expedite allowance of the application.

Respectfully submitted,

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